

REMARKS

In the Office Action of November 20, 2006, claims 1-3, 6-9, and 11-12 are pending. Claim 1 is an independent claim from which claims 2-3, 6-9, and 11-12 depend therefrom.

Claims 1-3, 6-9, 11 and 12 rejected under 35 USC 101

The office action rejected the pending claims under 35 USC 101 because the claimed invention lacks patentable utility. Specifically, the Examiner stated that the purpose for the “update” was not known.

An invention that fails the utility requirement does so for one of two reasons. First, an applicant can fail to identify any specific utility for the invention or fail to disclose enough information about the invention to make its utility immediately apparent to those familiar with the technological field of the invention. Second, the applicant’s asserted utility for the invention is not credible.

Neither of these two scenarios exists in the present application. The application clearly specifies specific utilities for the invention in paragraph 24 of the specification as filed. The “update” is a clear and defined term within both the specification and claims. Anyone familiar with the technological field of the invention would be immediately and acutely aware of the purpose and function. The invention disclosed and claimed is credible, fully disclosed, and would be widely apparent in light of the specification to one skilled in the art as to how to perform the invention. The Applicant respectfully asserts that the rejection based on 35 USC 101 is incorrect and should be withdrawn.

It is important to remember, however, that the PTO has the initial burden of challenging the applicant’s assertion of utility. This is true because the applicant’s assertion of utility in the disclosure will be initially presumed to be correct. Only if the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince the PTO of the invention’s asserted utility. The evidence necessary to show one skilled in the art would doubt the asserted utility is not present and therefore the rejection should be lifted.

Claims 1-3, 6-9, 11 and 12 rejected under 35 USC 112. second paragraph

The office action rejects the claims under 35 USC 112, second paragraph as being indefinite. Specifically the Examiner asserts that it is unclear to what is meant by “vehicle settings” and the term “passive off-board”.

With regard to the term “vehicle settings”, paragraph 24 of the specification as filed clearly defines what a “vehicle setting” contemplates. Specifically, the paragraph clearly lays out:

A vehicle setting may refer to a memory setting, a switch state, a variable setting, or some other type of vehicle setting known in the art. A vehicle setting may be a customer comfort and convenience setting, a vehicle performance setting, a vehicle safety system setting, a software setting, a communication setting, a diagnostic setting, a system configuration, a video or audio setting, a dealer option setting, a factory option setting, or other setting known in the art.

While the definitions contained therein may in fact be broad, they are not unclear. Additionally, anyone skilled in the art would clearly know what was a “vehicle setting” and what was not. The rejection should therefore be reconsidered.

With regard to the term “passive off-board” sufficient argument has been made during prosecution to consistently and unequivocally define the meets and bounds of the term “passive off-board”. The Examiner states that the term “passive” was only adequately defined during prosecution and not in the specification and therefore the 112 rejection is proper. The Federal Circuit, however, has unequivocally stated: “patentee may, of course, act as his own lexicographer and define a claim term in either the specification or the prosecution history. *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1327 (Fed.Cir.2001).”. *Intergraph Corp. v. Intel Corp.* 2004 WL 261002 *5 (C.A.Fed. 2004). The Applicant has adequately defined the term in the prosecution history and therefore the rejection should be lifted.

Claims 1-3, 6-9, 11 and 12 rejected under 35 USC 103(a).

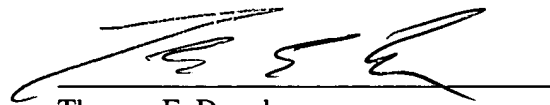
Claims 1-3, 6-9, and 11-12 stand rejected under 35 U.S.C. 103(a) as being anticipated by Salmeen et al (U.S. Pub. No. 2004/0114381) in view of Wolfe (2005/0228551). This rejection is inappropriate and should be lifted. The rejection utilizes an application as the basis for a 103(a) rejection that was neither filed, nor published, prior to the filing date of the present application. It cannot, therefore, be utilized as prior art as the basis for this rejection. In addition, the Salmeen reference was under an obligation to assign (and in fact is assigned to Ford Global Technologies, LLC) as the present application. Therefore, under 35 USC 103(c) the Salmeen reference should not be utilized as part of an obviousness rejection. The combination of references is inadequate to support a 35 USC 103(a) rejection and therefore the rejection should be overturned.

The Applicant incorporates all the prior arguments regarding the inapplicability of the Salmeen reference in addition to preserving all arguments regarding the insufficiency of evidence regarding a proper motivation to combine that would have needed to be established to support a 103(a) rejection. However, in light of the failure of the Wolfe reference to qualify as prior art, these arguments are presented in summary form to preserve brevity and PTO efficiency.

The application is now in condition for allowance and expeditious notice thereof is earnestly solicited. Should the Examiner have any questions or comments, the Examiner is respectfully requested to contact the undersigned attorney.

Respectfully submitted,

ARTZ & ARTZ, P.C.

A handwritten signature in black ink, appearing to read 'T. E. Donohue', written over a horizontal line.

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